

## **REMARKS**

### **I. General Remarks**

Prior to the above amendment, claims 1-10, 12-18, 20-34 and 37-44 were pending, and claims 13, 15, 23-29, and 37-44 were withdrawn from consideration by the Examiner. Claims 11, 19, 35, and 36 were cancelled. The Examiner finally rejected the pending claims on December 21, 2005. Applicants appealed this rejection to the Board of Patent Appeal and Interferences ("the Board") on May 22, 2006. An Oral Hearing before the Board was conducted on March 12, 2008. On March 25, 2008, the Board issued a Decision on Appeal.

In its decision, the Board upheld the Examiner's position that the cited references, Sweger<sup>1</sup>, Babenko<sup>2</sup>, Murray<sup>3</sup>, and Saint Leger<sup>4</sup>, support a prima facie case of obviousness with respect to claim 1.<sup>5</sup> See Decision on Appeal, page 4. In so doing, however, the board applied the cited references in a different manner than the Examiner.

Because this is a new ground of rejection, 37 C.F.R. § 1.1.196(b) prevents the Board from making the rejection final. Further 37 C.F.R. § 41.50(b) allows Applicants to 1) request rehearing under 37 C.F.R. § 41.52, or 2) reopen prosecution.

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<sup>1</sup> Sweger et al., U.S. Patent No. 5,482,704, issued Jan. 9, 1996.

<sup>2</sup> Babenko, U.S. Patent No. 6,277,893, issued Aug. 21, 2001.

<sup>3</sup> Murray, U.S. Patent No. 5,720,964, issued February 24, 1998.

<sup>4</sup> Saint Leger, U.S. Patent No. 5,919,438, issued July 6, 1999. The Board later states that Saint Leger "does not appear to be necessary to meet the limitations of claim 1" and thus does not discuss the reference in the Decision. Decision on Appeal, page 4. Accordingly, Applicants believe that the Board's rejection is premised on a combination of Murray, Sweger, and Babenko alone.

<sup>5</sup> Because the claims were not argued separately on appeal, claims 2-10, 12, 14, 16-18, 20-22 and 3-34 are considered by the Board to fall with claim 1. See Decision on Appeal, page 3 (citing 37 C.F.R. § 41.37(c)(1)(vii)).

As stated above, Applicants hereby re-open prosecution of this application to respond to the Board's rejection.

## **II. Status and Disposition of the Claims**

By the above amendment, claims 1, 23, 27, 29, and 30 are amended, and claims 20-22, 25, and 26 are cancelled. Thus, claims 1-10, 12, 14, 16-18, and 30-34 are now pending and under consideration on the merits.

As shown, claim 1 has been amended to further define the claimed silicone. In particular, claim 1 has been amended to largely include the silicones recited in previous claims 20-22, with the exception of a) polydimethylsiloxanes comprising dimethylsilanol end groups, b) silicone gums; and c) polyorganosiloxanes modified with functional groups other than substituted or unsubstituted amine groups. Support for this amendment may be found in original claims 20-22, and at page 32 of the as-filed specification. Claims 23, 27, 29, and 30 have been amended to take into account the amendments to claims 1 and the cancellation of claims 20-22, 25, and 26. Accordingly Applicants submit that the above amendments raise no issue of new matter.

As stated above in section I, the Board rejects all of the pending claims under 35 U.S.C. § 103(a) as allegedly obvious in view of a combination of Murray, Sweger, and Babenko. See Decision on Appeal, page 4. Applicants respectfully disagree with and traverse this rejection for at least the following reasons.

### III. Response to Claim Rejection

The Board rejects the pending claims under 35 U.S.C. § 103(a) as being allegedly unpatentable over a combination of Murray, Sweger, and Babenko. See *id.* Applicants respectfully disagree with and traverse this rejection for at least the following reasons.

In making a rejection under 35 U.S.C. § 103, the Office “bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. § 2142. In its decision in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the “framework for applying the statutory language of §103” was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation (“TSM”) test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a “rigid and mandatory” formula, the test can provide “helpful insight” to an obviousness inquiry. *Id.*

Applicant respectfully traverses this rejection because even if Murray, Sweger, and Babenko can be properly combined in the manner asserted by the Office, which

Applicants do not concede, the resultant combination does not possess each and every element of at least amended claim 1. In particular, the cited references do not teach a cosmetic composition comprising, *inter alia*, at least one “non-volatile polyorganosiloxane chosen from: -polyalkylsiloxanes chosen from polydimethylsiloxanes comprising trimethylsilyl end groups, and poly (C<sub>1</sub>-C<sub>20</sub>)alkylsiloxanes; - polyarylsiloxanes; - polyalkylarylsiloxanes; - silicone resins; and -polyorganosiloxanes comprising substituted or unsubstituted amine groups[,]” as claimed. See amended claim 1.

Murray discloses hair conditioning compositions containing *inter alia*, a non-volatile emulsion polymerized silicone *gum*, such as dimethiconol. The present claims, however, do not encompass silicone gums, and certainly do not encompass silicone gums comprising a polyalkylsiloxanes having dimethylsilanol end groups. For at least these reasons, Murray does not teach or even suggest each and every element of the present claims.

Sweger does not cure the deficiencies of Murray in this regard. Sweger discloses personal care compositions that may include an emulsion derived from, among other things, silicone oils and fats. See Sweger, column 4, lines 39-55. However, Sweger makes no mention of silicones falling within the scope of the present claims. Rather, Sweger discloses the use of dimethicone and dimethicone copolyol, which are the same or essentially the same as the silicones disclosed by Murray. See *id.* at columns 7-13, tables. Thus, like Murray, Sweger also does not teach or even suggest a composition comprising a silicone according to the claimed invention.

Babenko also fails to teach or even suggest a cosmetic composition comprising the claimed silicone. Babenko discloses oil-in-water emulsions for use in cosmetic compositions. See Babenko, column 1, lines 40-45. These emulsions contain a silicone copolyol of the structure shown by Figure II, and optionally dimethicone and/or cyclomethicone. See *id.* at columns 5-12, tables. However, none of these silicones fall within the purview of the present claims. At best, the disclosed silicone copolyol could be considered a polyorganosiloxane modified with an ether, but such a compound does not fall within the scope of present claim 1. As to dimethicone and cyclomethicone, these compounds are not encompassed within present claim 1 for the same reasons set forth above with respect to Murray and Sweger. Accordingly, like Murray and Sweger, Babenko also fails to teach or even suggest each and every element of the present claims.

For at least the foregoing reasons, Applicants submit that even if Murray, Sweger, and Babenko are considered to be properly combinable in the manner asserted by the Office, the resultant combination would still fail to achieve the claimed invention, including teaching the claimed silicone. Moreover, the Office has not provided a tenable rationale explaining *why* one of ordinary skill would modify the cited references so as to use a silicone within the purview of the present claims.

Thus, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness with respect to the currently pending claims. Applicants therefore submit that the 35 U.S.C. § 103(a) rejection applied by the Board is improper in view of the pending claims, and should be withdrawn.

**IV. Conclusion**

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

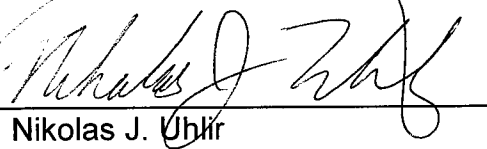
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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